

REMARKS

Claims 1, 7, 9, 11, 12, 13 and 18 are amended, but no new matter is added. With these amendments, claims 1-18 remain pending. The independent claims, each relating to the a method or apparatus for configuring uninterruptible power supply (UPS) devices, include the following:

- claim 1 (directed to a method for configuring UPS devices);
- claim 7 (directed to a computer for configuring UPS devices); and
- claim 13 (directed to an apparatus for configuring UPS devices).

Each of these claims specifies the use or inclusion of a plurality of configuration profiles for UPS devices and a list of UPS devices to be managed.

All pending claims (*i.e.*, claims 1-18) were rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent No. 6,219,703 (Nguyen *et al.*). As suggested by the patent's title, Nguyen *et al.* is directed to a device management information base in a network management station. In the only recited example of a "device" to be managed using the methods and apparatus of Nguyen *et al.*, a discussion of managing a router is provided at Col. 4, lines 21-23.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Even if we accepted that the UPS devices of the amended claims are a subspecies of the generic "devices" cited in Nguyen *et al.*, that genus-species relationship, of course, does not, in itself, establish obviousness. "The fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness." MPEP §2144.08(II) (citing *In re Baird*, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994)).

In the guidelines presented in MPEP §2144.08 for evaluating whether a claim specifying a species or subgenus is non-obvious, the following six criteria are set forth for determining whether one of ordinary skill in the art would have been motivated to select the claimed species or subgenus:

- (a) The size of the genus:

Here, the genus of "devices" that can be interfaced with a network is enormous, *i.e.*, encompassing nearly all modern electronic devices.

Consequently, the selection of a UPS device would not be suggested by a generic disclosure of a “device.”

(b) The express teachings of the prior art:

If the prior art reference expressly teaches a particular reason to select the claimed invention, Office personnel should point out the express disclosure which would have motivated one of ordinary skill in the art to select the claimed invention. An express teaching may be based on a statement in the prior art reference such as an art recognized equivalence.

MPEP, p. 2100-149. Here, Nguyen *et al.* does not teach a reason for selecting a UPS device as the “device.” Moreover, Nguyen *et al.* does not recognize an equivalence between a router (*i.e.*, a computer networking device that forwards data packets toward their respective destinations) and a UPS device (*i.e.*, a device for supplying power in the event of a power outage). Further still, there is no suggestion in the prior art relating to UPS devices for configuring UPS devices in this manner.

(c) The teachings of structural similarity:

This consideration appears to be most relevant for chemical inventions; nevertheless the section in the MPEP setting forth the guidelines approvingly provides the following cite:

“The section 103 requirement of unobviousness is no different in chemical cases than with respect to other categories of patentable inventions.” *In re Papesch*, 315 F.2d 381, 385, 137 USPQ 43, 47 (CCPA 1963).

MPEP, p. 2100-146 (quotation in source). Beyond the fact that the router and UPS device both are electronic devices, the two devices are not particularly similar from either a structural or functional standpoint.

(d) The teachings of similar properties or uses:

As noted, above, the UPS device of the amended claims is used to supply power to an electronic device, whereas a router is used to distribute data packets within a network. Accordingly, here is no more than minimal similarity between the properties and uses of these devices.

(e) The predictability of the technology:

If the technology is unpredictable, it is less likely that structurally similar species will render a claimed species obvious because it may not be reasonable to infer that the they would share similar properties.

MPEP, p. 2100-151. Because the species here are not structurally similar, and because this inquiry appears to be substantially more relevant in the context of chemical inventions, this inquiry appears to be of little consequence here.

(f) Any other teaching to support the selection of the species or subgenus:

The categories of relevant teachings enumerated above are those most frequently encountered in a genus-species case, but they are not exclusive. . . . In unusual cases, there may be other relevant teachings sufficient to support the selection of the species or subgenus and, therefore, a conclusion of obviousness.

MPEP, p. 2100-151. In this case, no other teachings support the selection of a UPS device for configuration in this context.

Accordingly, even if the management of routers in Nguyen *et al.* were otherwise similar to the management of UPS devices in the Applicants' amended claims, Applicants respectfully submit that there is no suggestion or motivation in the prior art for managing a UPS device in the same way that one skilled in the art would manage a router. To the contrary, UPS devices are not particularly comparable to, similar to, or related to routers so as to suggest the importation of the teachings of Nguyen *et al.* into the context of configuring UPS devices; and the above-discussed guidelines for evaluating genus-species obviousness do not support a determination that the

amended claims are obvious in view of Nguyen *et al.* Although the above discussion focused on the non-obviousness of the independent claims (*i.e.*, claims 1, 7, and 13), each of the other claims depends from one of these three claims and, therefore, incorporates its limitations; and each of the dependent claims is therefore non-obvious for the same reasons as the independent claims.

CONCLUSION

Based on the foregoing, this application is believed to be in allowable condition, and a notice to that effect is respectfully requested. The Examiner is invited to call the Applicants' Attorney at the number provided below with any questions.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert J. Sayre", written over a horizontal line.

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